REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. Claims 27, 31 and 32 have been amended, claims 12, 41 and 48 have been canceled and new claims 49-57 have been added. Claims 1-11, 13-40, 42-47 and 49-57 are pending in this application.

The amendments to the specification update related application data, address minor informalities noted during review and/or bring the drawings and specification into mutual conformance. No new matter is added by the amendments to the specification.

The amendments to claims 27, 31 and 32 address minor informalities noted during review and are not intended to alter the scope of the claims. No new matter is added by the amendments to claims 27, 31 and 32.

New claims 49-57 are supported at least by text appearing at page 5, line 13 through page 39, line 23 of the application as originally filed. New claims 49-52 et seq. are similar to claims 12, 41 and 48 but are presented in independent form, and such is not intended to alter the scope of such claims. Claims 53 et seq. are similar to claims 29 et seq. but differ in scope. No new matter is added by new claims 49 et seq. New claims 49 et seq. distinguish over the art of record and are allowable.

35 U.S.C. § 102

Claims 29-34 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,864,682 to Porter et al. (hereinafter "Porter"). Applicant respectfully disagrees and requests reconsideration.

Anticipation is a legal term of art. Applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

Porter is directed (see, e.g., Title) to a "method and apparatus for frame accurate access of digital audio-visual information". Porter teaches (see Abstract) that "A method and apparatus for use in a digital video delivery system is provided. A digital representation of an audio-visual work, such as an MPEG file, is parsed to produce a tag file. The tag file includes information about each of the frames in the audio-visual work. During the performance of the audio-visual work, data from the digital representation is sent from a video pump to a decoder. Seek operations are performed by causing the video pump to stop transmitting data from the current position in the digital representation, and to start transmitting data from a new position in the digital representation. The information in the tag file is inspected to determine the new position from which to start transmitting data. To

ensure that the data stream transmitted by the video pump maintains compliance with the applicable video format, prefix data that includes appropriate header information is transmitted by said video pump prior to transmitting data from the new position. Fast and slow forward and rewind operations are performed by selecting video frames based on the information contained in the tag file and the desired presentation rate, and generating a data stream containing data that represents the selected video frames. A video editor is provided for generating a new video file from pre-existing video files. The video editor selects frames from the pre-existing video files based on editing commands and the information contained in the tag files of the pre-existing video files. A presentation rate, start position, end position, and source file may be separately specified for each sequence to be created by the video editor. "

In contrast, claim 29 recites "One or more computer-readable media having stored thereon a computer program that, when executed by one or more processors, causes the one or more processors to perform functions including: receiving a user request at a client for a new playback speed of multimedia content being streamed as a plurality of individual streams to the client; and modifying the playback of each stream of the multimedia content in accordance with the new playback speed", which is not taught or disclosed by Porter.

Porter describes transmission of a stream of audio-visual data from a MPEG file to a client using, for example, MPEG-1 or MPEG-2 data formatting, and reception of the resulting stream by the client (see, e.g., Abstract, col. 1, lines 22-28, 35 and 36 and 46-49; col. 4 line 1 et seq.; col. 5, lines 39-44 etc.). Porter also describes reception, by a client, of a data stream representing both audio and

video information (col. 5, lines 46-52 etc.). Porter is clearly organized (col. 5, lines 10-35) to provide an overview, and then describes an audio-visual information delivery system 100 (Fig. 1 and associated text) and then more specific aspects within that framework with respect to subsequent Figs.

The cited portions (e.g., col. 5, lines 38-64; col. 6, lines 30-45; col. 16, lines 54-65; col. 17, lines 1-55 and col. 24, lines 1-55) do not disclose or describe transmission of multiple data streams representing multimedia content to a client and thus do not and cannot disclose or describe receiving "a user request at a client for a new playback speed of multimedia content being streamed as a plurality of individual streams to the client" or "modifying the playback of each stream of the multimedia content in accordance with the new playback speed", as affirmatively recited in claim 29.

Additionally, because Porter is silent with respect to transmission of a plurality of individual streams to a client, Porter cannot possibly teach or disclose that "the computer program further causes the one or more processors to perform functions including sending a message to each of a plurality of individual stream controls, the message indicating the new playback speed", as affirmatively recited in claim 30. The cited portions of Porter are silent with respect to any plurality of individual stream controls or any messages directed to such controls because Porter teaches a system whereby a single stream representing multimedia content is directed to each client, where different clients may be receiving different single streams representing different content.

Porter also does not teach or disclose that "the function of sending a message comprises a function of sending the message to an individual stream

control located at a server streaming the individual stream of the multimedia content", as recited in claim 31. Again, Porter is directed to a single data stream and thus cannot teach sending a message to one of a plurality of stream controls.

Porter additionally does not teach or disclose that "the computer program further causes the one or more processors to perform functions including each of a plurality of individual stream controls corresponding to the plurality of individual streams monitoring a master clock and adjusting a local clock to keep synchronized with the master clock", as affirmatively recited in claim 32. The Office Action cites (p. 3) col. 5, lines 38-64 in conjunction with the rejection of claim 32. This passage is void of any mention of any clock.

The Office Action also cites (p. 3) col. 16, lines 54-65 and col. 17, lines 1-55. These passages are also void of any mention of any clock. The passage on col. 17 describes "bit budgeting" as an embodiment (X) relating to a bandwidth conservation scheme and has no articulated relationship to the embodiment (IX) relating to variable playback operations described in the passage on col. 16.

The Office Action additionally cites (p. 3) col. 24, lines 19-40. This passage describes an embodiment (XVIII) relating to variable playback operations and is also devoid of any mention of any clock. Further, this passage has no articulated relationship to the embodiments referenced above.

Porter further does not teach or disclose that "the computer program further causes the one or more processors to perform functions including performing, by an independent stream control located at the client and corresponding to one of the plurality of individual streams, time-scale modification of the one stream in accordance with the new playback speed", as affirmatively recited in claim 33.

Porter explicitly teaches time scale modification to provide a single data stream by the server 110 (see e.g., col. 16, lines 60 et seq.; col. 17, line 6, et seq. and line 38 et seq.; col. 18, line 2 et seq. and line 51 et seq. etc.). Porter teaches such to correspond to a single stream, as noted above. Porter further does not teach modification of "the one stream" of "a plurality of streams" because Porter does not teach transmission of a plurality of streams to a client.

Moreover, Porter does not teach or disclose that "the multimedia content includes one or more of an image stream, a text stream, and an animation stream", as affirmatively recited in claim 34. Porter is silent with respect to animation streams. In fact, Porter is void of the term "animation".

Thus, claims 30-34 distinguish for their own recited features which are neither taught nor disclosed by Porter and by virtue of dependence from an allowable claim. The anticipation rejection of claims 29-34 thus also fails the tests noted above. As a result, the anticipation rejection of claims 29-34 is clearly prima facie defective and should be withdrawn, and claims 29-34 should be allowed.

35 U.S.C. § 103

Claims 1-28 and 35-48 stand variously rejected under 35 U.S.C. §103(a) as being unpatentable over Katseff et al. (hereinafter "Katseff"), U.S. Patent No. 5,822,537 in view of Porter. Applicant respectfully disagrees and requests reconsideration.

In responding to such a rejection, it is helpful to first review the subject matter addressed by the references. Porter has been at least partially discussed above with reference to the response to the anticipation rejection.

Katseff describes a "multimedia networked system detecting congestion by monitoring buffer's threshold and compensating by reducing video transmittal rate then reducing audio playback rate" (Title). More specifically, Katseff states (Abstract) that:

> Disclosed is a networked multimedia information system which may be utilized to record, store and distribute multimedia presentations together with any supplemental materials that may be referenced during the presentation. The recorded presentation, together with the associated supplemental materials, may be simultaneously presented on a display containing two separate viewing windows. The effects of network congestion are minimized by prefetching audio and video data for storage in audio and video buffers. An adaptive control algorithm compensates for network congestion by dynamically varying the rate at which video frames are retrieved over the network, in response to network traffic conditions. The audio playback speed is reduced if the audio data does not arrive fast enough over the network to maintain the desired size of the audio buffer after the amount of video data transmitted across the network has been reduced to a minimum value.

Kaseff teaches that a system relying on a single, combined data stream is preferred. Katseff teaches (col. 6, line 60 through col. 7, line 7) that:

> The data stream generated by the digitizer/compressor 360 is preferably in the JPEG Movie File format, which is described in "JPEG Movie File Specification, Release 1.0," Parallax Graphics,

> Inc., Santa Clara, Calif. (Nov. 5, 1992), incorporated herein by reference. The JPEG Movie File format interleaves one frames' worth of audio with a frame of video. For example, if video signals are being stored for a display rate of 10 frames per second (fps), the resulting interleaved data file will include a repeating pattern of one frame of video, followed by a tenth of a second's worth of audio.
>
> The JPEG Movie File format is preferred because of the inherent synchronization of the audio and video streams that results from the paired storage of a video frame with its associated audio, as discussed further below.

In contrast, independent claim 1 recites: "A method comprising: detecting, in a system for streaming a plurality of data streams from a server to a client, a potential overburdening of the system; selecting at least one of the plurality of data streams in response to detecting the potential overburdening of the system; and altering playback of the at least one data stream to avoid overburdening the system", which is not taught, disclosed, suggested or motivated by the cited references, alone or in any proper combination.

Katseff describes (col. 14, line 56 through col. 15, line 65) a system whereby the video portion of multimedia content is always the chosen portion for data reduction because "It has been found that a person viewing a recorded presentation will object more strongly to defects in the audio portion of the recorded program than to defects in the video portions of the presentation." (col. 15, lines 12-16). When system congestion is so great that even this is not enough, Katseff teaches that "the data buffer monitoring subroutine will compensate for the delayed arrival of audio data by playing the audio data form the audio buffer 110 at slower than real time" (col. 15, lines 63-65).

Katseff thus teaches away from "selecting at least one of the plurality of data streams in response to detecting the potential overburdening of the system",

as recited in claim 1, because Katseff has pre-determined which data stream will be selected when system congestion is detected. In fact, as noted above, Katseff teaches use of a data format that obviates multiple data streams representing multimedia content.

It is improper to employ a reference in a combination when the reference teaches away from the combination. This is explained more fully in MPEP 2145(X)(D)(2), entitled "References Cannot Be Combined Where Reference Teaches Away from Their Combination". This MPEP section states that: "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)".

The cited portions of Porter are silent with respect to detecting potential system overburdening. The text at col. 16, lines 54-65 merely describes an aspect of a fast forward operation. The text at col. 17, lines 1-55 describe an embodiment of data "thinning" for fast forwarding that is based on knowledge of available video pump bandwidth (see line 22 et seq.) and uses such to determine which or how many bits to transmit when transmission of such (rather than MPEG packets) would saturate the video pump 130. Additionally, as noted above, Porter teaches transmission of a single data stream to each client, and thus cannot possibly teach, disclose, suggest or motivate selecting at least one data stream from a plurality of data streams being transmitted to a client.

Porter addresses sequencing of packets using time stamps and a potential buffer overflow operation that can only occur during seek operations (see col. 15, lines 51-65 and esp. lines 56-63). Further, Porter resolves this difficulty by

"inserting data into the prefix data that will cause the arrival of the second large I-frame to the decoder buffer to be delayed" (col. 15, line 66 through col. 16, line 1) and states that "By the time all of the padding packets have been processed, the first I frame has been completely read out of the decoder buffer and the decoder buffer is ready to receive the second I-frame." This is intended to avoid altering playback modification due to limitations on buffer size; readout of I-frame data is allowed to complete in order to provide the corresponding image data.

The Office Action provides the naked conclusion that "It would have been obvious ...." but fails to identify any motivation in either reference to modify and/or combine teachings. There is no teaching or guidance identified within the references to aid one of ordinary skill in picking and choosing elements from the embodiments of the references or in assembling those elements to attempt to arrive at the subject matter of any of Applicant's claims. As such, the rejection employs an improper "obvious to try" standard of unpatentability.

Such is improper, as is discussed below in more detail with reference to MPEP §2145(X)(B), entitled "Obvious To Try Rationale". This MPEP section states that "The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general

guidance as to the particular form of the claimed invention or how to achieve it." *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted)".

In this instance, no guidance in selecting some but not others of the many elements from the embodiments of the references is identified. Similarly, no direction as to which of many possible choices is likely to be successful has been identified.

As there is no basis for the Examiner's contentions within the cited references, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for combining and/or modifying the teachings of the cited references. The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (*See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).)

Additionally, independent claim 13 recites: "A system comprising: a client computer coupled to a network; a server computer coupled to transmit a plurality of individual data streams to the client computer via the network; and wherein the client computer is to detect when bandwidth from the server to the client computer that is allotted to transmitting the plurality of individual data streams would be exceeded and take action to prevent the allotted bandwidth from being exceeded", which is not taught, disclosed, suggested or motivated by the cited references, alone or in combination.

The Office Action cites portions of Katseff (p. 9) but fails to identify any portion of Porter as supplying deficiencies of Katseff. Col. 4, lines 55-67 and col. 5, lines 1-6 of Katseff describe a still image storage and retrieval system 60 operable with the system 10 of Fig. 1, which is described generally at col. 3, lines 47-67. Col. 14, line 56 through col. 16, line 31 is reproduced below:

> NETWORK CONGESTION
>
> In order to compensate for congestion on network 20 that causes the delayed arrival of audio and video data, the video process will preferably prefetch audio and video frames from the respective file server 40 for storage in audio and video buffers 110, 115, respectively, on the user's workstation to minimize the effect of network congestion on the playback of the recorded presentation. Since two-way video conferencing applications demand rapid response times, the buffering of audio and video data would not normally be tolerated in such applications. It is noted, however, that during the playback of recorded presentations the buffering of audio and video data would not be detected by a user.
>
> According to one feature of the invention, the networked multimedia system compensates for congestion on network 20 using an adaptive control algorithm to dynamically vary the rate at which video frames are retrieved from the respective file server 40 over network 20, in response to increases or decreases in the amount of other data being transmitted across the network 20. For a discussion of an illustrative adaptive control algorithm, see section 2.3 of the Continuous Media Player reference, incorporated above.
>
> In order to maximize the playback quality of the recorded presentation, the audio component of the recorded presentation is preferably given preference over the video component. It has been found that a person viewing a recorded presentation will object more strongly to defects in the audio portion of the recorded presentation than to defects in the video portions of the presentation.
>
> In a preferred embodiment, the video process utilizes a data buffer monitoring subroutine, illustrated in FIG. 10, to maintain a pre-defined amount of audio and video data in the audio and video buffers 110, 115. The data buffer monitoring subroutine will continuously monitor the audio and video buffers 110, 115 during step 1000, until the amount of audio or video data stored in the audio or video buffers 110, 115 drops below a predefined threshold value, as detected by step 1010.

If it is determined during step 1010 that the amount of audio or video data in the audio or video buffers 110, 115, respectively, has fallen below the desired threshold value, the data is not arriving at the workstation 15 from the respective file server 40 over network 20 as fast as it is being presented to a user by the workstation 15. Thus, the data buffer monitoring subroutine will reduce the requested video playback rate during step 1015 by requesting that the file server 40 transmit fewer video frames per second to the workstation 15. It is noted, however, that the data buffer monitoring subroutine will preferably continue to request all of the audio data from the file server 40.

After the requested video playback rate is reduced during step 1015, a test is performed during step 1020 to determine if the amount of audio or video data in the audio or video buffers 110, 115 is still below the desired threshold value. If it is determined during step 1020 that the amount of audio or video data in the audio or video buffers 110, 115 has risen above the desired threshold value, program control will proceed to step 1060, discussed below.

If, however, it is determined during step 1020 that the amount of audio or video data in the audio or video buffers 110, 115 is still below the desired threshold value, a test is performed during step 1025 to determine if the requested video playback rate has been reduced to the minimum value, i.e., a playback rate of 0 frames per second (fps).

If it is determined during step 1025 that the requested video playback rate has not yet been reduced to the minimum value, program control will return to step 1015 for a further reduction in the requested video playback rate.

If it is determined during step 1025 that the requested video playback rate has been reduced to the minimum value, network congestion conditions are so extreme that even though no video data is being transmitted across the network 20, the audio data is still not arriving fast enough over the network 20 to maintain the desired size of the audio buffer 110. In a preferred embodiment, the data buffer monitoring subroutine will compensate for the delayed arrival of audio data by playing the audio data from the audio buffer 110 at slower than real-time.

Thus, the data buffer monitoring subroutine will begin playing the audio at a reduced speed during step 1030. The data buffer monitoring subroutine will continue playing the audio at the reduced speed until it is determined during step 1040 that the amount of audio data in the buffer has returned to the desired threshold value. Once it is determined during step 1040 that the amount of audio data

in the buffer is greater than or equal to the desired threshold value, the data buffer monitoring subroutine will resume playing the audio at a normal, or real-time, speed during step 1045. Thereafter, program control will return to step 1000, and continue in the manner described above.

The data buffer monitoring subroutine could play the audio at half-speed during step 1030, e.g., by dividing each frames' worth of buffered audio data into n segments and then playing each segment twice. If it is desired to play the audio at a speed between half speed and normal speed, not all of the n segments are played twice. Similarly, if it is desired to play the audio at a speed less than half speed, some of the n segments may be played more than twice.

In a preferred embodiment, the data buffer monitoring subroutine will gradually adjust the playback speeds of the audio during steps 1030 and 1045 in order to make the transition from one speed to another less noticeable to a listener. For example, the data buffer monitoring subroutine can reduce the audio playback rate during step 1030 according to a scale that gradually adjusts the playback rate between a defined maximum and minimum audio playback rate. In addition, by monitoring the rate at which the audio buffer 110 is emptying, the data buffer monitoring subroutine can determine how quickly the audio playback rate should be reduced during step 1030 and what the minimum audio playback rate should ultimately be.

In capsule form, this passage describes a system whereby the client adapts a playback rate for information that has already been transmitted, and whereby the server 40 determines that bandwidth limitations result in a need to modify video information being transmitted. In this system, the client determines when an audio or video buffer capacity falls below a threshold (block 1010, Fig. 10) and notifies the server 40 (block 1015). The client also determines when available buffer capacity exceeds a threshold (block 1020), and requests an increase in the amount of data shipped (block 1060). Neither of these have any clear relationship to determination of available bandwidth, determination of status of such by a client or other features recited in claim 13.

The Continuous Media Player reference noted in this passage is discussed in col. 5, lines 7-31, reproduced below:

> The continuous media storage and retrieval system 70, together with file server 40, provides storage and retrieval functions for a collection of databases, such as databases 95, 100, containing continuous media, such as video, audio and animated graphics. For a discussion of an illustrative continuous media storage and retrieval system 70, see Lawrence A. Rowe and Brian C. Smith, "A Continuous Media Player," Proc. 3d Int'l Workshop on Network and Operating System Support for Digital Audio and Video, San Diego, Calif. (Novenber [sic] 1992), incorporated herein by reference. The Continuous Media Player system is available from the University of California, Berkeley.
>
> The continuous media storage and retrieval system 70, such as the Continuous Media Player system referenced above, preferably provides the mechanism for digitizing and compressing audio, video and other continuous media for storage by a number of distributed file servers, in a manner described further below. In addition, the continuous media storage and retrieval system 70 provides the mechanism for accessing stored continuous media data files over network 20 for presentation on a workstation, such as workstation 15.
>
> Alternatively, the continuous media storage and retrieval system 70 may be embodied as the multimedia network system commercially available from Fluent, Inc., now called Novell Multimedia.

As such, the adaptive control algorithm noted at col. 15, line 9 appears to be implemented at the server side. No portion of Katseff has been identified in the Office Action that even suggests determination of bandwidth issues by the client.

Further, independent claim 20 recites "A server computer comprising: a bus; a memory system, coupled to the bus, to store a plurality of instructions; and a processor, coupled to the bus, to execute the plurality of instructions to: receive an indication that time-scale modification for a data stream that was previously performed at a client computer should now be performed at the server computer, and transmit a time-scale modified data stream to the client computer", which is

not taught, disclosed, suggested or motivated by the cited references, alone or in combination.

The portion of Porter (col. 17, lines 1-11) cited in the Office Action (p. 11) is silent with respect to any "data stream that was previously performed at a client computer", as recited in claim 20. Further, this passage is silent with respect to performing any such data stream at a server, as recited in claim 20. It merely indicates that a "bit budgeting" algorithm may be used to transmit a data file to a client.

Moreover, independent claim 24 recites "An apparatus comprising: a master control component to maintain a master timeline for a multimedia presentation; and a plurality of individual stream controls corresponding to individual data streams for the multimedia presentation, wherein each of the plurality of individual stream controls is to maintain a timeline for the corresponding individual data stream", which is not taught, disclosed, suggested or motivated by the cited references, alone or in combination. The Office Action does not cite any portions of Porter with respect to claim 24.

Katseff, as noted above, describes a still image system at col. 4, lines 1-11 and lines 55-60. Col. 6, line 60 through col. 7, line 7, teaches that a single data stream representing multimedia content is preferred.

As such, Katseff fails to describe "a plurality of individual stream controls corresponding to individual data streams for the multimedia presentation, wherein each of the plurality of individual stream controls is to maintain a timeline for the corresponding individual data stream", as recited in claim 24. Katseff teaches use

of a data format that obviates any need for such, and, as such, teaches away from the recitation of claim 24.

Yet further, independent claim 35 recites "A method comprising: receiving streaming text from a server; receiving a user request to change a playback speed of the streaming text; and altering the playback speed of the streaming text in accordance with the user request", which is not taught, disclosed, suggested or motivated by the cited references, alone or in combination. Katseff describes a system whereby video playback speeds are modified (col. 13, line 61 through col. 7, line 6) and is silent with respect to modification of "a playback speed of the streaming text" as recited in claim 35.

As well, independent claim 42 recites "A method comprising: receiving a plurality of images as streaming image data from a server; receiving a user request to change a playback speed of the plurality of images; and altering the playback speed of the plurality of images in accordance with the user request", which is not taught, disclosed, suggested or motivated by the cited references, alone or in combination. The cited portions of Katseff describe a system and a still image storage and retrieval system 60 and are silent with respect to any user request to change a playback speed of a plurality of images or altering the playback speed, as recited in claim 42.

Yet further, simply providing a conclusory statement that "It would have been obvious ...." fails to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2142, entitled "Legal Concept of Prima Facie Obviousness" (see also MPEP §706.02(j).).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims. Accordingly, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim.

Accordingly, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness as set forth in the MPEP.

Moreover, no evidence has been provided as to why it would be obvious to combine or modify the teachings of these references. Evidence of a suggestion to combine or modify may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

To recapitulate, the unpatentability rejections and/or the cited references (i) fail to provide the elements recited in the claims, (ii) the references are not properly combinable because they teach away from each other and the claimed subject matter, (iii) employ an improper "obvious to try" standard, (iv) employ impermissible hindsight, (v) do not meet the criteria for a finding of unpatentability and (vi) do not appropriately identify motivation to modify/combine.

Dependent claims 2-12, 14-19, 21-23, 25-28, 36-41 and 43-48 (as filed) distinguish for their own recited features and by virtue of dependence from allowable claims. Accordingly, the unpatentability rejection of claims 1-28 and 35-48 is defective and should be withdrawn, and claims 1-28 and 35-48 should be allowed.

Conclusion

Claims 1-11, 13-40, 42-47 and 49-57 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned

attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: Jan 26, 2004

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